

#### **IV. REMARKS**

Claims 1-3 and 5-6 are pending in this application. By this amendment, claim 1 has been amended, and claims 7-20 have been canceled. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Office, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the Office. Applicants do not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-3, 5 and 6 are rejected under 35 U.S.C. §101 as allegedly being directed to nonstatutory subject matter. Claims 1-3 and 5-20 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to meet the written description requirement. Claims 1-3 and 5-20 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Cappellucci et al. (U.S. Pat. Pub. No. 2003/0039949 A1), hereinafter “Cappellucci,” in view of Advanced Distributed Learning ADL SCORM Version 1.3 Application Profile, Working Draft 0.9 [2002-11-27], hereafter “ADL.”

##### **A. REJECTION OF CLAIMS 1-3, 5 AND 6 UNDER 35 U.S.C. §101**

The Office has rejected claims 1-3, 5 and 6 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter because the claims fail to produce a tangible effect. However, Applicants note that since the Office Action was mailed, the Federal Circuit decided *In*

*Re Bilski*, and outlined a two pronged analysis as the sole test for determining whether a process is directed to patentable subject matter. Under the first prong, a process is directed to patentable subject matter if it is tied to a particular machine or apparatus. *In Re Bilski*, No. 2007-1130, Slip Op. at p. 10 (Fed. Cir. Oct. 30, 2008). Under the second prong, a process is directed to patentable subject matter if it transforms a particular article into a different state or thing. *Id.* In the analysis under the second prong, the particular article can be a physical object or substance or an electronic signal representative of a physical object or substance. *Id.* at p. 28. To this extent, the analysis utilized by the Office in the rejection of claim 1 is not a valid analysis for determining whether a process claim is directed to patentable subject matter.

Applying the *Bilski* test to amended claim 1, Applicants respectfully submit that the claimed invention qualifies as patentable subject matter as being directed to a process that is tied to a particular machine or apparatus. For example, the claimed invention uses a computer device to perform the steps and writes the hierarchical tree to a computer readable medium of a computing device. As such, Applicants respectfully request that this rejection be withdrawn.

## **B. REJECTION OF CLAIMS 1-3 AND 5-20 UNDER 35 U.S.C. §112**

Claims 1-3 and 5-20 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office argues that there is not support in the original specification for the limitation “outputting the hierarchical tree.” Because this limitation is only present in claim 1, Applicant assumes that this rejection is actually directed to claims 1-3 and 5-6, not claims 7-20. While Applicants do not agree with this rejection or argument, in order to expedite an allowance of the claims, Applicants have amended this

limitation to “writing the hierarchical tree to a computer readable medium of a computing device.” This writing of the hierarchical tree to a computer readable medium of a computing device is inherent in the discussion of a computer-implemented process in the specification, *see e.g.*, Paragraphs [0022]-[0026], [0031] and FIG. 3. As such, Applicants respectfully request that this rejection be withdrawn.

#### **C. REJECTION OF CLAIMS 1-3 AND 5-20 UNDER 35 U.S.C. §103(a)**

With regard to the 35 U.S.C. 103(a) rejection of claims 1-3 and 5-20, Applicants respectfully submit that the references cited by the Office fail to teach each and every element of the claimed inventions.

For example, with respect to claim 1, the cited references fail to teach or suggest “performing an information rollup using a computer device of the parent node only after performing the information rollup of the first child node and the information rollup of the second child node, eliminating repeated rollups of the parent node.” In contrast, neither Cappellucci nor ADL, cited by the Office, teaches eliminating repeated rollups of the parent node. The Office argues that the linking of information in a table in Cappellucci, i.e., the correlation query, is equivalent to the information rollup of the claimed invention. (Final Office Action, p. 10-11). The Office then cites to Para. [0066] of Cappellucci which states that the “correlation step need only be performed once when new information is added” for support for its argument that repeated rollups of a parent node are eliminated, as required by the claimed invention. (Final Office Action, p. 11). Applicants respectfully disagree with this argument. First, the correlation query of Cappellucci is not equivalent to the information rollups of the claimed invention.

Secondly, Cappellucci does not teach a system wherein a parent node is only rolled up after first and second child nodes are rolled up. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Moreover, neither of the cited references teaches or suggests “generating a control block using a computer device for each of the first child node, the second child node and the parent node prior to the first performing step, wherein the control block for the parent node indicates that the information rollup of the first child node and the information rollup of second child node must both be performed prior to performing the information rollup of the parent node” as in claim 1. The Office cites to the meta data that populates the database in Cappellucci for disclosure of this element. Office Action, p. 5. However, this population of meta data is not equivalent to the control blocks of the claimed invention, which are generated for each of the first child node, the second child node, and the parent node, prior to the first performing step. In contrast to the meta data of Cappellucci, the control blocks of the claimed invention indicate that the information rollup of the first child node and the second child node must be performed prior to performing the information rollup of the parent node. Accordingly, Applicants respectfully request that the rejection be withdrawn.

With regard to the Office’s other arguments regarding dependent claims, Applicants herein incorporate the arguments presented above with respect to claim 1. In addition, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve the right to do so should it become necessary. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

## **V. CONCLUSION**

In addition to the above arguments, Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

Date: December 2, 2008

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